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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/494,240 | 01/30/2000 | Bill J. Pope | 6056P | 3185 |

7590 04/04/2002

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|--------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/494,240 | POPE ET AL. |
| | Examiner Brian E Pellegrino | Art Unit 3738 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 January 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-24 and 38-79 is/are pending in the application.

4a) Of the above claim(s) 9-15, 19, 20, 22, 24, 50, 55, 59-61 and 70-72 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8, 16-18, 21, 23, 38-49, 51-54, 56-58, 62-69 and 73-79 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

18) Interview Summary (PTO-413) Paper No(s) _____.

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____.

DETAILED ACTION

Claim Objections

Claim 39 is objected to because of the following informalities: the claim depends from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 51-54, 56-58, 62, 63, 67-69, 73, 76-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Buechel et al. (5702448). Fig. 1 shows a femoral head 18 having a convex articulating surface. Buechel et al. disclose a prosthetic device with a smooth articulating surface having a substrate coated with diamond, col. 10, lines 27-42 and col. 11, lines 1-4. Buechel also discloses to polish the coating, col. 8, lines 47-49 and col. 9, lines 23-25. See col. 6, lines 37-56 for metals used for the substrate. Buechel et al. additionally disclose that CoCr can be used as the metal, col. 10, lines 57-58. It is inherent that the materials have CTEs and moduli that are different. The coating formed on the substrate is crystalline in structure, col. 8, lines 1-2 and can be interpreted to include interstitial spaces in diamond layer since it has "pores" lines 4-6.

Claims 1-8, 16-18, 21, 23, 38-49, 51-54, 56-58, 62-69 and 73-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Pope et al. (5645601). Pope et al. disclose a femoral head made of metal, col. 3, lines 6, 7. Pope discloses the head has a diamond

layer compact bonded to the substrate by sintering at high temperatures, col. 3, lines 29-33. The diamond is polished at an Ra value that falls within the claimed range of 0.005 to 0.5 microns. Since the process of coating the substrate with the diamond layer is performed the same way, the examiner asserts that the claimed measured properties (in this case, interstitial spaces in diamond layer and gradient zones) are present in the prior art to some extent even though they are not explicitly recited. Therefore, the examiner hereby burdens the applicant to show that these measured properties are not present in the prior art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8,16-18,21,23,38-49,51-54,56-58,62-69 and 73-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 41-49, 57-82 of U.S. Patent No. 6290726. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the claims are similar in scope with the femoral head being claimed in the present application and the combination of the head and its corresponding articulation surface in US PN 6290726. Therefore the present claims are read on by the patented claims; *In re Goodman*.

Response to Arguments

Applicant's arguments filed 1/15/02 have been fully considered but they are not persuasive. In response to Applicant's argument that Buechel does not include certain features of Applicant's invention, the limitations on which the Applicant relies (polycrystalline diamond compact on the surface of the femoral head) is not stated in the claims rejected upon by Buechel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino
TC 3700, AU 3738

March 28, 2002


Paul Prebilic
Primary Examiner

